

REMARKS

In the Office Action, claims 1-10 and 33-37 were rejected. By this Response, Applicant has amended claims 1, 9, 10, and 33. Upon entry of the amendments, claims 1-10 and 33-37 will remain pending in the present patent application. In view of the foregoing amendments and the following remarks, Applicant respectfully requests reconsideration and allowance of all pending claims.

Rejection Under Section 102

In the Office Action, claims 1, 2, 4, 6-10, 33, 34, 36, and 37 were rejected under 35 U.S.C. § 102(b) as anticipated by the Anderson reference (U.S. Patent No. 2,659,796; hereinafter “Anderson”). In rejecting these claims, the following interpretation of Anderson was presented:

Anderson discloses a torch head (20), a thermal storage member (24-26) to absorb heat from the torch member, wherein the thermal storage member [is] isolated from the torch head. The thermal storage member is metal copper. A [sic] electrically conductive tube operable to conduct electricity and gas to the torch head and heat from the torch head to the thermal storage member, wherein the thermal storage member is disposed around at least a portion of the tube (figure 1). The torch head is air-cooled and operable to conduct 300 amps at 60% duty cycle with a temperature increase of less than 30K.

Office Action mailed July 26, 2005, p. 2.

Applicant, however, respectfully submits that a *prima facie* case of anticipation cannot be established in view of Anderson, because Anderson does not disclose all of the features recited in the pending claims. As will be appreciated, anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *See Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to

anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *See In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). And “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Thus, the prior art reference must show the *identical invention “in as complete detail as contained in the ... claim”* to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Additionally, for anticipation, the cited reference must not only disclose all of the recited features but must also disclose the *part-to-part relationships* between these features. *See Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 486 (Fed. Cir. 1984). Accordingly, Applicant needs only point to a single element or claimed relationship not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. A *strict correspondence* between the claimed language and the cited reference must be established for a valid anticipation rejection.

As will also be appreciated, during patent examination, the pending claims must be given an interpretation that is reasonable and consistent with the specification. *See In re Prater*, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); *In re Morris*, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); see also M.P.E.P. § 2111 (describing the standards for claim interpretation during prosecution). Indeed, the *specification* is “the primary basis for construing the claims.” *See Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005) (citations omitted). It is usually dispositive. *See id.* Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *See In re Cortright*, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); *see also* M.P.E.P. § 2111. That is, recitations of a claim must be read as they would be interpreted by those of ordinary skill in the art. *See Rexnord Corp. v. Laliram Corp.*, 60 U.S.P.Q.2d 1851, 1854 (Fed. Cir. 2001); *see also* M.P.E.P. § 2111.01. In summary, an examiner, during prosecution, must interpret a claim recitation as one of ordinary skill in the art

would reasonably interpret the claim in view of the specification. *See In re American Academy of Science Tech Center*, 70 U.S.P.Q.2d 1827 (Fed. Cir. 2004).

With the foregoing in mind, Applicant respectfully demonstrates below that Anderson does not anticipate the pending claims, the independent claims and certain dependent claims of which are addressed in turn.

Amended Independent Claims 1 and 33 and the Claims Depending Therefrom

For example, Applicant respectfully submits that Anderson does not disclose “a thermal storage member disposed *internally* with respect to the welding implement,” as recited in independent claim 1, nor does Anderson disclose “a metallic member disposed *internally* with respect to the welding implement,” as recited in claim 33. (Emphasis added.) Instead, the concentric fins 24, 25, and 26 of Anderson—which the Examiner contends are equivalent to the claimed thermal storage member and metallic member (*see* Office Action mailed July 26, 2005, p. 2) – are wholly located externally with respect to the alleged torch head 20. *See* Anderson, FIG. 1. Indeed, these concentric fins 24, 25, and 26 of Anderson are formed in the gas nozzle 4 and are designed to reduce heat in the nozzle 4— not in any torch head. *See id.* at col. 3, ll. 66-72.

Additionally, Applicant submits that Anderson does not disclose features recited in the dependent claims of the present application. For example, Anderson does not disclose “an electrical insulator disposed over the thermal storage member,” as recited in amended independent claim 10. Instead, as is, again, best illustrated in FIG. 1 of Anderson, no elements are disposed over the fins 24, 25, and 26 of the gas nozzle 4. Indeed, these fins 24, 25, and 26 are wholly exposed to the environment, demonstrating that no material, let alone an insulator material, is disposed thereover.

As yet another example, Applicant respectfully submits that Anderson does not disclose a welding implement in which “the torch head is air-cooled and operable to conduct 300 Amps at a 60% duty cycle with a temperature increase of less than 30K,” as recited in claims 8 and 37. Nothing in Anderson gives any indication that such a specific operability is even possible in the disclosed device. As argued previously, for anticipation, an examiner must ensure that if a claimed feature is not expressly disclosed in a cited reference, it must then be *necessarily* present in the thing described in the cited reference. *See In re Robertson*, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999). The mere fact that a certain *may* result from a given set of circumstances is not sufficient. *See id.* Thus, in the present case, Applicant respectfully resubmits that it has not been shown that the specific operability claimed in dependent claims 8 and 37 is *necessarily* present in the device of Anderson. Moreover, it has not even been attempted to establish, through a line of scientific reasoning or otherwise, that the Anderson device inherently discloses the claimed operability of claims 8 and 37. Only a wholly conclusory assertion about what Anderson discloses has been presented, and Applicant respectfully submits that such assertions are not sufficient to support a *prima facie* case of anticipation.

Based on the foregoing, Applicant respectfully submits that claims 1, 2, 4-10, 33, 34, 36, and 37, as pending, are not anticipated by Anderson. Thus, Applicant respectfully requests reconsideration and allowance of claims 1, 2, 4-10, 33, 34, 36, and 37.

Rejections Under Section 103

In the Office Action, dependent claims 3 and 35 were rejected under Section 103 as obvious in view of Anderson. Applicant, however, respectfully submits that dependent claims 3 and 35, which depend from claims 1 and 33, respectively, are patentable by virtue of their respective dependencies on allowable base claims and also by virtue of the additional features recited therein. Accordingly, Applicant respectfully requests reconsideration and allowance of dependent claims 3 and 35.

Conclusion

If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Date: October 26, 2005

Manish Vyas
Reg. No. 54,516
FLETCHER YODER
P.O. Box 692289
Houston, TX 77269-2289
(281) 970-4545